



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,237	10/31/2003	Nobuyuki Nonaka	SHO-0045	9024

23353 7590 01/11/2007
RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

21

Office Action Summary

Application No.

10/697,237

Applicant(s)

NONAKA, NOBUYUKI

Examiner

Robert Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/22/4, 5/19/5, 11/1/5, 5/19/6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements submitted June 22nd, 2004, May 19th, 2005, November 1st, 2005, and May 19th, 2006 have been considered by the Examiner, and a copy of each respective statement including the Examiner's notation has been included for the Applicant's records.

Claim interpretation

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an **apparatus must be distinguished from the prior art in terms of structure rather than function**. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. (See *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987), *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971), *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959), and MPEP 2114).

The instant case Claim 5 is directed to a manner of operating a previously structure rather a modification of said previously defined structure. If the Applicant

Art Unit: 3714

intends for these limitations to be considered as possible distinguishing features of their claimed invention they must be appropriately presented within the confines of a method type claims. For the purposes of this action these limitations have been correlated to the prior art of record for the purposes of further prosecution.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-2** and **4-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Ozaki et al (US 2001/0031658).

Ozaki teaches a pattern display device for a game machine including, a game value providing means for providing a game value to the player when a predetermined game result is displayed (Paragraph 12), a game result determination and game display section (Paragraphs 9-11) wherein the game display section wherein, a first plurality of display sections (Elements 30a-30c) is located behind a second and third plurality of display sections (Figure2, Elements 27a-c, 28a-c) and further includes a shutter unit capable of transparently displaying or blocking/concealing the display output of the first

Art Unit: 3714

plurality of display sections on the third plurality of display sections in a changeable manner (Paragraphs 137-139).

The second and third plurality of display sections of Ozaki are further taught to be included in a window component or equivalently described one-piece construction (Figure 2, Paragraph 42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki et al (US 2001/0031658).

Ozaki teaches the invention as recited above however is silent regarding the separation of a singular shutter unit into multiple shutter units, however this separation of a singular component of Ozaki into multiple components would have been well known

Art Unit: 3714

to a person of ordinary skill in the art at the time of invention. It would have been obvious to one of ordinary skill in the art at the time of invention to separate the singular shutter of Ozaki et al into multiple components in order to allow the selective concealment of the design reels and accordingly allow a greater number of game outcomes.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki et al (US 2001/0031658) as applied to claim 1 above, and further in view of Loose et al.

Though the limitation of operating of the shutter structure to conceal a first display device when the game outcome is determined to be shown on a second display device are presently described as a method of operation or intended use and therefore fail to further define the structure of the claim invention as set forth above however, in the interests of further prosecution the following rejection is presented to address such claim features were they to be presented in the appropriate form.

Ozaki is arguable silent regarding the operating of the shutter structure to conceal a first display device when the game outcome is determined to be shown on a second display device. However in a related invention Loose et al teaches the use of a equivalent shutter means to conceal a reel first display when a game result is displayed on a second display device (Loose Col 5:24-51, Figures 6-7). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the game state responsive shutter means of Loose in the invention of Ozaki in order to utilize the existent hardware in Ozaki to produce a game result that is absent visual information which non-relevant to the present game state.

Conclusion

The following prior art is made of record and though not relied upon is considered pertinent to Applicant's disclosure.

Loose et al (US 6,517,433) teaches a reel spinning outcome with superimposed video image.

Suganuma et al (7,121,945) teaches a combined representation display method.

Lally et al (US 3,642,287) teaches the selective concealment of slot machine reels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

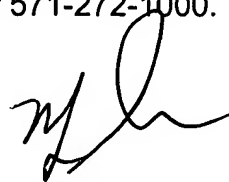
Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 5th, 2007

RM

RM



MARK SAGER
PRIMARY EXAMINER